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09/752,330	12/29/2000	Ravindra R. Mantena	YOR920000552US1	8671
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HESLIN ROTHENBERG FARLEY & MESITI PC			GART, MATTHEW S	
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3625

DATE MAILED: 03/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/752,330

Applicant(s)

RAVINDRA R. MANTENA

Examiner

Matthew s Gart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

### **DETAILED ACTION**

In view of the Appeal Brief filed on January 20, 2004, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claims 1-36 were originally presented in the instant application. No claims have been canceled, amended or added.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-3, 9-15, 21-27 and 33-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Conklin et al. U.S. Patent No. 6,338,050.**

Referring to claim 1. Conklin et al. discloses a method of providing an entitled price in an electronic transaction comprising:

- Electronically sending by a requestor a request for an entitled price from a public electronic environment (at least column 23, lines 19-36, "Thus, the present invention enables the collection and storing of negotiations and results data in a highly secure hosting environment over a public network");
- Automatically routing the request to a private electronic environment (at least column 18, lines 38-47, "The present invention allows the creation of one or more sponsored communities of any number of types for conducting iterative negotiations over a network. As seen in FIG. 1a, the network used is the present-day Internet with TCP-IP protocols and formats, but those skilled in the art will appreciate that it could also be implemented on any future open network(s) which might replace or supplement the Internet, or it could be implemented inside current, private networks within a corporation, if desired");
- Obtaining the entitled price within the private electronic environment while the requestor waits (at least Abstract, "...allows a seller/participant to use remote authoring templates to create a complete Website for immediate integration and activation in the community, to evaluate proposed buyer orders and counteroffers, and to negotiate multiple variables such as price, terms, conditions, etc., iteratively with a buyer."); and

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- Automatically returning the entitled price from the private electronic environment to the public electronic environment for providing to the requestor (at least Abstract).

Referring to claim 2. Conklin et al. further discloses a method wherein the public electronic environment comprises:

- A front end application (at least column 11, line 60 to column 12, line 14);
- Wherein the private electronic comprises a back end Enterprise Resource Planning (ERP) application, wherein the electronically sending comprises electronically sending by the requestor the request via the front end application, wherein the automatically routing comprises automatically routing the request to the ERP application, wherein the obtaining comprises obtaining the entitled price from the ERP application while the requestor waits, and wherein the automatically returning comprises automatically returning the entitled price from the ERP application to the front end application for providing to the requestor (at least Abstract).

Referring to claim 3. Conklin et al. further discloses a method wherein the automatically routing and the automatically returning are accomplished at least in part by messaging middleware.

Referring to claim 9. Conklin et al. further discloses a method wherein the public electronic environment comprises a global computer network, and wherein the front end application comprises a browser (at least column 2, lines 3-11).

Referring to claim 10. Conklin et al. further discloses a method wherein the electronic transaction takes place at least partially over the global computer network, wherein the electronically sending comprises electronically sending the request from the browser to a global computer network site server, and wherein the automatically routing comprises:

- Forwarding the request from the global computer network site server to messaging middleware (at least column 20, line 61 to column 21, line 18);
- Sending the request from the messaging middleware to the ERP application (at least column 20, line 61 to column 21, line 18); and
- Causing by the messaging middleware a command to be issued to the ERP application (at least column 20, line 61 to column 21, line 18).

Referring to claim 11. Conklin et al. further discloses a method wherein the automatically returning comprises:

- Sending the entitled price from the ERP application to the messaging middleware (at least column 20, line 61 to column 21, line 18);
- Forwarding the entitled price from the messaging middleware to the global computer network site server (at least column 20, line 61 to column 21, line 18); and
- Returning the entitled price from the global computer network site server to the browser (at least column 20, line 61 to column 21, line 18).

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Referring to claim 12. Conklin et al. further discloses a method comprising encrypting and decrypting communications between the browser and the global computer network site (at least column 33, line 48-64).

Referring to claims 13-15 and 21-24. Claims 13-15 and 21-24 are rejection by the same rationale set forth above in claims 1-3 and 9-12.

Referring to claims 25-27 and 33-36. Claims 25-27 and 33-36 are rejected by the same rationale set forth above in claims 1-3 and 9-12.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 4-8, 16-20, and 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conklin et al. U.S. Patent No. 6,338,050 in view of**

Referring to claim 4-8. Conklin discloses a method according to claim 3 as indicated supra. Conklin further discloses a method wherein the automatically returning is accomplished via a plurality of messaging middleware systems.

Conklin does not expressly disclose a method wherein the messaging middleware comprises MQSERIES, MSMQ and the ESP application comprises BAAN. Multiplatforms teach that enterprise software vendors have come to support multiple platforms (Multiplatforms: page 2). The examiner notes, the specific type of middleware

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being utilized by the instant invention does not act to distinguish the instant invention in terms of patentability. Numerous middleware applications and ESP configurations could have been implemented and successfully utilized. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of Conklin to have included various middleware applications and ESP configurations as discussed above because multiple platform support from ERP vendors and greater platform interoperability means that manufacturing manages can consider a wider range of applications (Multiplatforms: page 3).

Referring to claims 16-20. Claims 16-20 are rejection by the same rationale set forth above in claims 4-8.

Referring to claims 28-32. Claims 28-32 are rejected by the same rationale set forth above in claims 4-8.

### ***Response to Arguments***

Applicant's arguments concerning claims 4-8, 16-20 and 28-32 filed on 20 January 2003 have been fully considered but are moot in view of the new grounds of rejection

Applicant's arguments concerning claims 1-3, 9-15, 21-27 and 33-36 filed on 20 January 2003 have been fully considered but they are not persuasive.

The Appellant argues (Page 5 of the Appeals Brief) that there is no disclosure, teaching or suggestion in Conklin of an entitled price.

The specification of the instant invention defines an entitled price as a negotiated price between a buyer and one or more sellers of goods. Such negotiated prices are



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referred to as an entitled price, which is the price a buyer is entitled to for a given item based on an entitlement, such as, for example, a contract with the seller or a promotional offer from the seller.

The Examiner notes, Conklin discloses a system and method which allows a buyer to search and evaluate seller information, propose and negotiate orders and counteroffers that include all desired terms (abstract).

The Examiner further notes, the buying process shown in **FIG. 1g** includes search and evaluate process **70**, which enables a prospective buyer to find companies and their products in the community and investigate their prices, terms and service offerings. If a buyer is interested in opening negotiations with a particular seller, the propose orders processes can be based on catalog prices or desired prices and other terms. In this case the buyer can view a seller's price in a catalog, then negotiate a new price with that seller based on other relevant procurement factors.

For example, manufacturers in the computer industry might want to agree on a set of multi-part, multi-tiered industry standards for a new computer bus. A computer industry association or a standards association might be the community sponsor, and the computer and peripheral manufacturers might be the participants who need to iteratively negotiate with each other and/or the standards body to agree upon the standards. The sponsoring standards body establishes the community, proposes initial standards, sets the rules for negotiations encourages and monitors negotiations and concludes with a finally agreed upon set of standards, with each step of each negotiation that occurred along the way archived. Since no additional hardware or

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software needs to be installed at the sponsor's site or at those of any of the participants, the present invention provides a much more economical and speedy way to negotiate complex, multivariate items such as complex standards specifications (column 17, lines 39-56). This negotiation results in a contract between two parties, which specifies an entitlement offer. Most business negotiation processes are usually multivariate. That is, a business negotiation deals with many variable items, such as price, quantity, quality, shippers, insurance, warranty, schedules, returns and so on. Conklin aims to automate these multivariate negotiations (column 1, lines 40-45) whereby two parties can agree upon a binding contract.

The Appellant argues (Page 6 of Appeal Brief) that Conklin does not disclose automatically routing the request to a private electronic environment.

The Appellant admits (Page 6 of Appeal Brief) that Conklin speculates the use of private networks.

The Examiner notes, the present invention allows the creation of one or more sponsored communities of any number of types for conducting iterative negotiations over a network. As seen in **FIG. 1a**, the network used is the present-day Internet with TCP-IP protocols and formats, but those skilled in the art will appreciate that it could also be implemented on any future open network(s) which might replace or supplement the Internet, or it could be implemented inside current, private networks within a corporation, if desired (column 18, lines 38-47).

The Examiner further notes claim 1 of the instant invention, in short, defines a public-to-private system. Conklin defines a system that could be implemented on any

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type of system including public-to-public networks, private-to-private networks, private-public networks, and public-to-private networks. Those skilled in the art will appreciate that all of multivariate negotiations engine functions could be placed behind a private firewall (column 23, lines 5-20).

The Appellant argues (Page 7 of the Appeal Brief) that in the instant application the entitlement is already known, whereas Conklin is providing a forum for the parties to agree to a price (i.e., the price is not yet known in Conklin until after negotiations have ended).

The Examiner notes claim 1 of the instant application claims, "Electronically sending by a requestor a request for an entitled price from a public electronic environment." In both the instant invention and Conklin the buyer is requesting an entitled price. There is nothing claimed in claim 1 on how that entitled price is generated (i.e. through negotiations, or generated via a database). In both instances a buyer requests an entitlement price and the system allows the seller to transmit an entitlement price to the buyer. Furthermore, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Appellant argues (Page 7 of the Appeal Brief) that Conklin does not disclose a system wherein the entitled price is obtained while the requestor waits.

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The Examiner notes, Conklin discloses a multivariate negotiations engine for international transaction processing which: enables a sponsor to create and administer a community between participants such as buyers and sellers having similar interests; allows a buyer/participant to search and evaluate seller information, propose and negotiate orders and counteroffers that include all desired terms, request sample quantities, and track activity; allows a seller/participant to use remote authoring templates to create a complete Website for immediate integration and activation in the community, to evaluate proposed buyer orders and counteroffers, and to negotiate multiple variables such as prices, terms, conditions etc., iteratively with a buyer (abstract). This iteration is a dynamic process between two parties whereby as one of the parties is preparing to act, the other party is waiting for the submission. Nowhere in the instant application is a time limit set on a user's wait.

The Appellant argues (Page 8 of the Appeal Brief) that Conklin does not disclose obtaining the entitled price from the ERP application while the requestor waits.

The Examiner notes, another external function **211** of the present invention shown in FIG. 1m, is the ability to incorporate application-programming interfaces (API's) 211-04. Since the present invention is designed from the "outside looking in" (from the network looking into the enterprise) as it were, the data from transactions completed using it might have to be transferred manually to internal seller and buyer system formats without API 211-04 functions. With API 211-04 functions, the data that is stored internally by the present invention, can be reformatted by an API designed for a particular seller or buyer's internal systems. For example, if a seller has accepted all

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the terms of an open buying agreement against which a buyer has now placed an order, the seller might use an API 211-04 to "translate" that data into a format the seller's internal ERP systems can accept for order processing.

### ***Conclusion***

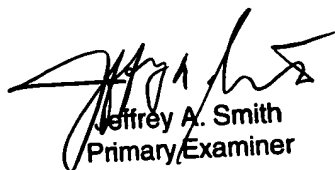
Any inquiry concerning this communication should be directed to Matthew Gart whose telephone number is 703-305-5355. This examiner can normally be reached Monday-Friday, 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MSG

February 26, 2004

  
Jeffrey A. Smith  
Primary Examiner